

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-19 are now present in this application. Claims 1, 6, 11 and 16 are independent.

Priority Under 35 U.S.C. §119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. §119, and receipt of the certified priority document.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statement filed July 18, 2003, and for providing Applicants with an initialed copy of the PTO-1449 form filed therewith.

Statutory Double Patenting Rejection

Claims 6-15 stand rejected under 35 USC §101 based on double patenting of the “same invention” type over claims 6-15 of U.S. patent 6,603,659. This rejection is respectfully traversed.

The Office Action asserts that the only difference between claims 6 and 11 in this Application and in the ‘659 patent is that the claim preamble language is different. The Office Action also indicates that the different preamble language “appears to add no structure to the heat dissipater.” The Office Action concludes by stating that claims 7-10, 12-15 in the application and patent claim the same structure features.

Applicants respectfully submit that claims 6-15 of this Application are not of the same scope as claims 6-15 of U.S. Patent 6,603,659 and, therefore, claims 6-15 of this Application are not claiming the same invention, per 35 USC §101, as claims 6-15 of the “659 patent.

A rejection is proper under 35 U.S.C. §101 only if the claimed inventions are identical in scope, because an inventor is entitled to a single patent for an invention. See In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Several unpublished decisions of the USPTO Board of Appeals and Interferences have reached the same conclusion. Examples of these are Tsuruta v. Nordella, 60 USPQ2d 1827 (BPAI 2001); Ex parte Schmit, 64 USPQ2d 1723 (BPAI 2000); and Ex parte Davis, 56 USPQ2d 1434 (BPAI 2000). These cases reference In re

Vogel, 164 USPQ 619 (CCPA 1970). The Court in the Vogel decision clearly indicates that claims reciting “pork” were not of the same scope as claims reciting “meat.” The unpublished Board decisions also indicate that claims reciting “halogen” do not the same scope as claims reciting “chlorine.” See, also, in this regard, In re Goodman, cited above.

Claims 6-10 of the ‘659 patent recite a “heat dissipater for an optical writing and/or reproducing apparatus,” whereas claims 6-10 of this Application recite a “heat dissipater for an electrical apparatus.” Just as halogen differs in scope from chlorine, i.e., as a genus to a species, and just as meat differs in scope from pork, i.e., as a genus to a species, so “heat dissipater for an electrical apparatus” clearly differs in scope from “heat dissipater for an optical writing and/or reproducing apparatus,” i.e., as a genus to a species. Accordingly, claims 6-10 of the ‘659 patent and claims 6-10 of this Application are not claiming the “same invention” in terms of 35 USC §101, and this statutory double patenting rejection is improper and should be withdrawn with respect to claims 6-10.

Concerning the assertion that the preamble language of the claims adds no structure to the heat dissipater, Applicants respectfully disagree. In this regard, reference is made to a 1994 decision by the Court of Appeals for the federal Circuit, In re Paulsen, 31 USPQ2d 1671 (Fed. Cir. 1994), in which the preamble claim language term “computer” was held to give life and meaning to claims, to

properly define the invention, and to represent an additional structural feature of the claims.

For example, claim 16 of the Paulsen patent states:

“16. A portable computer constructed to be contained within an outer case for transport and to be erectable to a viewing and operating configuration for use, said computer comprising

a base,

a display housing,

a top cover,

a rear cover,

hinge means for permitting swinging movement of the display housing about an axis of rotation adjacent the rear end of the display housing and from a closed and latched position of the display housing on the base to an erected position for viewing by an operator, and wherein

the base is metal and including logic board means in the base and power

supply board means mounted in the base to use the metal base as a heat sink

for dissipating the heat produced by the major heat producing components of

the electrical circuitry located in the base, and

the power supply board means include power supply components mounted on the underside of the power supply board, a metal bracket, and a leaf spring engaging the metal base and wherein the power supply components transfer

the heat to the metal base through the metal bracket and the leaf spring.”

(emphasis added)

Like the claims in this application, claim 16 of the Paulsen patent, recites an electrical apparatus in the preamble and the body of the claims. Claims 6-10 of this application and claim 16 of the Paulsen patent also recite a heat sink for electrical apparatus.

Applicants respectfully submit that the claim preamble language “a heat dissipater for an electrical apparatus” in this Application gives life and meaning to claims 6-10 of this Application, just as the preamble language “computer” was determined to give life and meaning to claim 16 of the Paulsen patent (4,571,456). In other words, claims 6-10 of the ‘659 patent and claims 11-15 of this Application are not claiming the same invention, per 35 USC §101.

Similar arguments apply to claims 11-15 of this Application, which recite “a heat dissipating structure adapted for dissipating heat generated in an electrical apparatus” and claims 11-15 of the ‘659 patent, which recite “a heat dissipating apparatus for dissipating heat generated in an optical writing and/or reproducing apparatus.” In other words, claims 11-15 of the ‘659 patent and claims 11-15 of this Application are not claiming the same invention, per 35 USC §101.

Accordingly, Applicants respectfully submit that this rejection of claims 6-15 under 35 USC 101 as claiming the same invention as claims 6-15 of the '659 patent is improper and should be withdrawn.

Allowed Subject Matter

Applicant acknowledged with appreciation the allowance of claims 1-5 and 16-19.

Additional Cited References

Since the remaining references cited by the Examiner, including those listed on the PTO-1449 initialed by the Examiner, have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Application No.: 10/621,381

Art Unit 2835

Reply to Office Action dated March 18, 2004

Attorney Docket No. 3449-0261P

Page 8

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

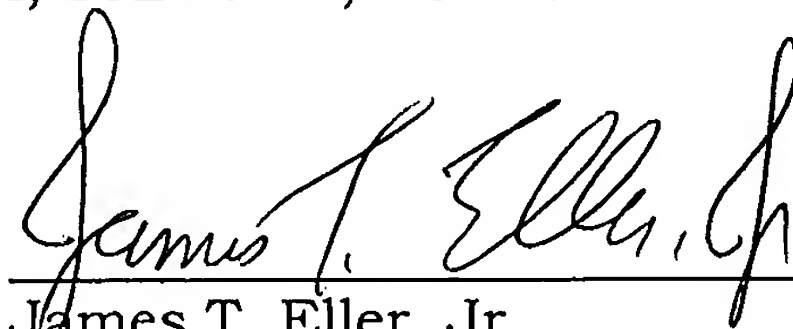
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,


BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:



James T. Eller, Jr.

Reg. No.: 39,538

JTE/RJW/adt 

P.O. Box 747

Falls Church, Virginia 22040-0747

Telephone: (703) 205-8000